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| 10/774,340      | 02/06/2004  | Asutosh Nigam        | 8500-0256.10        | 5320             |

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REED INTELLECTUAL PROPERTY LAW GROUP  
1400 PAGE MILL ROAD  
PALO ALTO, CA 94304-1124

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| EXAMINER |
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JACKSON, MONIQUE R

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| ART UNIT | PAPER NUMBER |
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1773

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,340

Applicant(s)

NIGAM, ASUTOSH

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 21-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Upon reconsideration, the restriction requirement of prior office action dated 2/8/05 has been withdrawn, however the election of species requirement is still proper.
2. Applicant's election of species comprising a monomeric polyacid, specifically maleic acid, and a monomeric polybase, specifically ethylenediamine, in the reply filed on 3/8/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 10-20 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/8/05.

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 45, 52 and 60 recite that the reflective surface is holographic however the specification falls to provide proper antecedent basis for a holographic surface.

### ***Claim Objections***

5. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 29 depends upon Claim 28 wherein it is noted that the range

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recited in Claim 29 is broader than the range recited in Claim 28 and hence does not further limit Claim 28.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation “wherein the image is a metallic-looking image.” It is unclear what is meant by the term “metallic-looking”. What set of criteria determine whether an image is “metallic-looking?” How “metallic” must an image appear to be considered “metallic-looking?” It is unclear whether one of ordinary skill in the art would be reasonably apprised of the metes and bounds of the claimed subject matter.

8. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation “wherein the monomeric polyacid has the structural formula (I)... $(L_x\text{CCOOH})_y]_z$  wherein: R is....structural formula (II)... $C(L_x\text{CNR}^1\text{R}^2)_y]_z$ ”. It is first noted that the two formulas have a closing square bracket “]” between y and z but do not include an opening “[“ square bracket making it unclear as to what the coefficient “z” is to be applied. Further it is noted that though the claim recites “R is” after the recitation of formula (I) there is no “R” in formula (I) and hence there is insufficient antecedent basis for this limitation in the claim.

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9. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 recites the limitation "the opaque coating agent" and "the image-enhancing composition". There is insufficient antecedent basis for these limitations in the claim.

10. Claims 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 recites the limitation "the film-forming binder". There is insufficient antecedent basis for this limitation in the claim.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 41, 43, 44, 47, 50, 51, 56, 58 and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Netsch et al (USPN 6,364,993.) Netsch et al teach a process in which a substrate including paper, metal, plastic and glass (inclusive of reflective and/or glossy), with an image formed thereon is overlaid with a transparent material that is, in turn, coated with an opaque coating composition (Col. 3, lines 13-49.) The opaque coating composition hides or shields the image on the substrate from visual perception (Col. 3, lines 41-45.) The dried opaque coating composition is contacted with water to reveal the image on the substrate (Col. 4, lines 36-49) wherein the Examiner takes the position that the water taught by Netsch to render the coating transparent reads upon the instantly claimed "recording liquid." Netsch et al further teach that

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the opaque coating composition is aqueous and comprises a binder and a pigment in an amount of from about 5wt% to about 40wt% (Col. 5, line 23; Col. 2, lines 59; Claim 6.)

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Netsch et al in view of Lee (USPN 5,163,846.) The teachings of Netsch et al are discussed above but do not specifically disclose that the image formed on the substrate is produced using a writing instrument as instantly claimed. However, Lee teaches a process similar to that of Netsch et al in which an opaque coating composition is rendered transparent by the application of water thereto, thereby revealing the substrate beneath. In the process of Lee, water is applied with a water pen that may be used to draw or write (Figure 1, water pen 32.) It is the Examiner's position that this water pen reads upon the instantly claimed "writing instrument" wherein it would have been obvious to one having ordinary skill in the art to modify the process of Netsch et al so as to apply the water utilizing a water pen as suggested by Lee hence allowing the water to be applied in any desired pattern.

15. Claims 45, 46, 52-54, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Netsch et al. The teachings of Netsch et al are discussed above. Though Netsch et al teach that the substrate to be printed may be metal, paper, plastic or glass, Netsch et al do not specifically teach that the substrate is a paper/metal laminate or a metallized substrate

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as instantly claimed. However, considering Netsch et al teach that paper, metal and plastic are all suitable substrate materials, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any combination or laminate of these suitable substrate materials wherein a metallized film is an obvious species of metal/plastic laminate or metallization of a substrate or film is an obvious method of producing a laminate comprising a metal layer. With respect to instant claims 45, 52 and 60, though Netsch et al do not teach that the substrate comprises a holographic surface, considering Netsch et al is directed to decorative items comprising a metal surface, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide any design or decorative pattern, wherein a holographic design is an obvious species of decorative designs having a metallic surface or appearance, and hence would have been obvious based on the desired end use of the product taught by Netsch et al given the reasonable expectation of success.

### ***Double Patenting***

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims are 47 and 49-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32 and 34-40 of U.S. Patent No.

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6,723,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are fully encompassed by USPN '383. The Examiner notes that the instant application is a divisional application of USPN '383 resulting from a restriction requirement, however, it is noted that the elected invention of '383 included the process of the above cited claims with an election of species of polymeric polybase and polymeric polyacid. Considering claim 47 is a generic claim that is not directed to the non-elected species only, the above-cited claims do not correspond to the non-elected invention/species of the parent application and hence a double patenting rejection is appropriate.

18. Claims 1-9 and 21-62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60, 62, 68-70, 80-91, 84, and 90-111 of copending Application No. 10/314855 (Notice of Allowance mailed 2/7/05, Printed as US 2004/0109958.) Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations and to utilize any combination of the claimed materials for the opaque coating. Further, the Examiner notes that though the claims of the copending application are directed to a product while the instant claims are directed to the product as well as the process, the instantly claimed process would have been obvious based on the claimed product of '855 considering the instantly claimed process only includes minimal process steps, i.e. printing an image would have been obvious from "a printed image" and applying an opaque coating composition to a substrate would have been obvious from "a substrate coated with...an opaque coating composition."

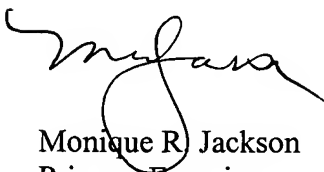


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R Jackson  
Primary Examiner  
Technology Center 1700  
May 9, 2005